

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Steven R. Boal	Art Unit :	3622
Serial No. :	09/451,160	Examiner :	Arthur D. Duran
Filed :	November 30, 1999	Conf. No. :	8692
Title :	ELECTRONIC COUPON DISTRIBUTION SYSTEM		

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
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**REPLY BRIEF**

Applicant files this reply brief under 37 C.F.R. § 41.41, in response to the Examiner's Answer mailed October 22, 2008 ("Examiner's Answer").

The sections provided under M.P.E.P. 1208 and by 37 C.F.R. § 41.37 follow.

**(1) Status of Claims**

Claims 1-18 and 22-50 are pending and rejected, with claims 24, 26 and 44 being independent. Claims 19-21 were canceled during prosecution. Applicant appeals the rejection of claims 1-18 and 22-50.

**(2) Grounds of Rejection to be Reviewed on Appeal**

Claims 24 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Linden** ("Linden", U.S. Patent No. 6,360,254) in view of **Barnett** ("Barnett", U.S. Patent No. 6,321,208).

Claims 1-18, 22, 23, 47, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Linden** in view of **Barnett** and in view of **Lang** ("Lang", U.S. Patent Application Publication No. 2003/0083931).

Claims 26-46 and 49-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Lang** in view of **Barnett**.

**(3) Argument**

**Section 103(a) Rejections**

Claims 24 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over

Linden in view of Barnett.

Claim 24 recites in part receiving a coupon from a server, and associating a Uniform Resource Locator (URL) with the coupon, the URL containing a promotional code.

**A. Linden does not receive a coupon**

In the "Response to Argument" section of the Examiner's Answer, the Examiner cites to various sections of Linden directed to one-time-use hyperlinks 74 (e.g., URLs) that are provided to the users for redeeming electronic gift certificates. *See* page 15, lines 13-16 of the Examiner's Answer.

As discussed in the previous Brief on Appeal ("Appeal Brief"), Linden's hyperlinks 74 are generated to automate the process of redeeming gift certificates, not coupons. *See* page 5, line 23 to page 6, line 17 of the Appeal Brief; *see also* col. 10, lines 58-59 of Linden. As emphasized in the Appeal Brief, a gift certificate is not a coupon. A gift certificate is a convenient form of entitlement that allows a bearer to select and receive a product (or service) up to a specified value as set forth in the gift certificate. The gift certificate represents a completed transaction, in that the gift certificate has been purchased previously. Subsequent to the purchase, the gift certificate can be redeemed by the purchasing party or another entity (i.e., hence the name "gift" certificate).

By contrast, a coupon is a document that entitles a bearer to a discount or other compensation in the event that a future transaction is completed in accordance with the terms associated with the coupon. The discount (e.g., a discount percentage, fixed price reduction) or other compensation (e.g., receipt of a second similar item, receipt of a different item, etc.) is one term of the terms specified in the coupon. Other terms include other requirements that set forth the nature of the future transaction and the associated compensation that will be provided to the presenter in the event that the specified transaction is completed. A coupon is not itself a negotiable instrument, as evidenced often by the phrase "no cash value" that can be found on many popular forms of coupons. It should be noted that in order to receive a gift certificate, the purchaser has to pay something of value, whereas a coupon does not require, for example, an upfront expenditure.

Accordingly, Linden fails to teach or suggest receiving a coupon from a server. For at least this reason alone, claim 24 is allowable over the relied upon portions of Linden.

**B. Barnett does not receive a coupon and associate the coupon with a URL**

The Examiner maintains that even if Linden does not provide a coupon, that Barnett does. *See* page 17, lines 15-18 of the Examiner's Answer. Specifically, in this portion of the Examiner's Answer, the Examiner relies on Barnett, suggesting that Barnett's server provides a coupon. While Applicant concedes that the relied upon portions of Barnett provide coupons, such are provided in a manner that is different than Applicant's claimed receiving a coupon and associating it with a URL. Barnett's coupon is downloaded by a user onto the user's computer so that the user can print out the coupon for redemption. *See* col. 9, lines 59-67. Barnett's coupon, however, is not associated with a URL. Applicant respectfully asserts that the proposed combination of Linden and Barnett fails to teach or suggest Applicant's claimed receiving of a coupon from a server and associating the coupon with a URL.

**C. Neither Linden nor Barnett teach or suggest receiving a coupon, associating the coupon with a URL where the URL includes a promotional code**

The Examiner reiterates his previous position that Linden's token in the URL associated with the gift certificate corresponds to Applicant's promotional code. *See* page 19, line 20 to page 20, line 15 of the Examiner's Answer. Additionally, the Examiner cites case law directed to interpreting claims in the broadest reasonable manner to justify his interpretation. *See* page 18, lines 11-21 of the Examiner's Answer.



As an initial matter, and as shown above and discussed in the Appeal Brief, Linden's token "A9HBJE55GOML" is included in a URL for accessing a gift certificate, not a coupon. *See* Fig. 10 of Linden; *see also* page 5, line 22 to col. 6, line 17 of the Appeal Brief (discussing

how the token is generated). Applicant also respectfully asserts that the Examiner's interpretation of Linden's token as Applicant's claimed promotional code is meritless. A promotional code identifies a promotion. Linden's token value is a code that identifies a data record corresponding to a particular user. *See* col. 6, lines 37-39. Linden's token is a text string generated based on a user's email address and a time stamp (e.g., during which the token is valid). *See* col. 8, lines 13-16 and col. 9, lines 1-4. Linden's token is not a promotional code. Nor does the token point to or relate to any promotion (e.g., a buy-one-get-one-free voucher, \$2.00 off coupon or free shipping offer, etc.). By contrast, a URL associated with a coupon may be, for example, associated with a prior event (e.g., a previous order) or a contemporaneous event.

For at least these reasons, Applicant respectfully submits that claim 24 is allowable over the proposed combination of Linden and Barnett. Claim 25 depends from claim 24, and also is submitted to be allowable for at least the same reasons discussed above.

#### **Claim 26**

Claims 26-46 and 49-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Lang** in view of **Barnett**.

#### **A. Lang and Barnett Do Not Disclose Or Suggest Collecting Device Information From A Client, the Device Information Being Insufficient To Specifically Identify A User**

Claim 26 recites in part collecting device information from a client system, the device information being insufficient to specifically identify a user of the client system.

#### **i. The Examiner's reliance on the word "may" to justify his position that Lang's uses of personal information is optional is improper**

In the "Response to Argument" section of the Examiner's Answer, the Examiner admits that Lang "may" use the actual name of the users and other personal information about the users, such as the name, gender, age, occupation, marital status, to further target the users. *See* page 24,

lines 15-22 of the Examiner's Answer. Nevertheless, the Examiner continues to maintain that such uses are optional as inferred by the word "may". See page 25, lines 1-3 of the Examiner's Answer.

The Examiner's reliance on the word "may" fails because Lang expressly teaches that one object of the invention is to allow advertisers to track the web sites and files visited by customers on the Internet, and that a second object of the invention is to allow advertisers to track the "past, present, and future physical locations of their customers," such as by GPS (global positioning system) satellites. See [0011]-[0012] and [0015]. As the collection of this highly personal information is the "object of the invention," there is no suggestion in the relied upon part of Lang that the collection of this information is in any way optional.

**B. Lang's registration requires personal information**

Even assuming *arguendo* that Lang's tracking procedure does not include collecting personal information, this is not the only information that Lang collects. Lang's tracking procedure initially requires a user to register, which includes receiving personal information from the user. Specifically, a client software program 22 supplied by the operator of the central server 50 must first be loaded onto the user laptop 15. See [0024]. The user's personal information is then entered into the client software program 22 by the user 10. *Id.* Such personal information includes "name, physical address and email address". See [0031]. In response, the central server 50 issues an electronic device ID information to the user laptop 15, and the user laptop 15 connected to the WAN 8 is subsequently identified based on this electronic device ID information. See [0024]. While during a given tracking operation no specific user information may be gathered, the user is still identified by this previously established ID. Applicant respectfully asserts that the Examiner picked a portion of the tracking process to suit his needs without considering the entire process.

The user is required to submit personal information to the central server 50 in order to establish an account. Applicant respectfully asserts that there is no suggestion that the submission of such personal information is in any way optional, or that an account can be

granted to a user without the submission of personal information or identification of the user to the central server 50.

Applicant respectfully asserts that Lang's system does not teach or suggest collecting device information from a client system, the device information being insufficient to specifically identify a user of the client system. For at least these reasons, Applicant respectfully submits that claim 26 is allowable over Lang and Barnett, alone or in combination. Claims 27-43 and 49 depend from claim 26, and also are submitted to be allowable for the same reasons discussed with respect to claim 26.

#### **Claim 44**

Claim 44 recites in part means for collecting device information being insufficient to specifically identify a user.

As discussed above, neither Lang nor Barnett disclose or suggest collecting device information being insufficient to specifically identify a user. Rather, the proposed combination of Lang and Barnett provides means that provides the identity of the user.

For at least these reasons, Applicant respectfully submits that claim 44 is allowable over the proposed combination of Lang and Barnett.

Claims 45-46 and 50 depend from claim 44, and also are submitted to be allowable for at least the same reasons discussed with respect to claim 44.

For at least these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

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Respectfully submitted,

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